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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,300

Applicant(s)

HAUSER, BRUCE H.

Examiner

Sam Chuan C. Yao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As far as the Examiner can tell, no express support can be found for the newly added limitation "*pre-forming ... and, subsequently attaching ...*" per claim 1, without any guidelines/guidance from Counsel/Applicant as to where support might be found, this engenders a New Matter situation.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A process step of providing an impervious covering material to a resultant reinforcing strip (i.e. serpentine wire and at least one longitudinal carrier member) in claim 1 is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claim 1 is directed to a method of making a sealing strip (see the preamble). However, it is unclear how one in the art (wanting to practice the claimed invention) can effectively use a resultant reinforcing strip as a

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sealing strip, when the reinforcing strip has a plurality of *"voids located between, said interconnected reinforcement clips extending the strip length"*.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite, because it is unclear what is intended by the limitation: *"pre-forming said continuous strand of wire ..."*

Claim 3 is indefinite, because the phrase *"said filler layer"* does not have a positive antecedent basis.

Claim 5 is indefinite, because the phrase *"said U-shaped profile"* does not have a positive antecedent basis.

Claim 8 is indefinite, because the phrase *"the longitudinal carrier material"* does not have an antecedent basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 4, 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by King (6,461,713).

King discloses a method of making a carrier for use as a reinforcement of an extruded elastomeric sealing strip (taken to be the recited filler material), the method comprises folding a wire filament (4) transversely back and forth across a width to form a serpentine frame (40) and then welding an elongation reducing member oriented in an axial direction (30; taken to be the recited carrier member). See the abstract; column 3 lines 63-67; column 4 lines 2-30; column 5 lines 1-10; column 6 lines 13-67; column 7 line 61 to column 8 line 28; column 9 lines 25-32; figures 1 and 4-9. Note: the elastomeric sealing strip is taken to be the recited filler material because this strip encapsulates a resultant reinforcing carrier (col. 1 lines 6-27).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-2, 4, 6-7, 9-10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumiya (US 5,204,157) in view of King (US 6,461,713) and optionally further in view of Bright (US 4,699,837).

With respect to claims 1,4,6-7,9 and 20, Matsumiya discloses a method of making an elongated carrier for productions of door seals, the method comprises

bending a wire (3) transversely back-and-forth to form a zig-zag serpentine configuration; and attaching a plurality of axially oriented strands (9,11,13) onto the serpentine configuration (col. 2 lines 41-43, col. 3 lines 24-38, col. 5 lines 55-66 and col. 8 lines 17-23; figures 1 and 3-4). Matsumiya further teaches that the application of axially oriented strands is not limited to knitted wire carriers; also teaches applying axially oriented tapes onto a serpentine configuration by *"stitching, welding, adhesive, or any other way"* (col. 2 lines 40-46; col. 5 lines 55-66; col. 7 lines 14-26; figure 4). It is unclear however, whether Matsumiya contemplates pre-forming a continuous zig-zag serpentine configuration and then attaching axially oriented strands onto the serpentine configuration without stitching. However, such would have been obvious in the art, because: a) as noted above, Matsumiya is not restrictive to attaching axially oriented tapes or strands to a zig-zag serpentine configuration by stitching; and, b) it is old in the art to make a preformed zig-zag serpentine configuration and then to weld (i.e. without stitching) an axially oriented elongation reducing strands to the preformed a zig-zag serpentine configuration as exemplified in the teachings of King (col. 9 lines 25-32; figures 1-2). Bright is optionally cited as further evidence that it is conventional and well known in the art to manufacture a preformed serpentine zig-zag configuration (figures 2 and 5).

With respect to claim 2, see claims 32-36 of the Matsumiya patent and figures 6-7 of the Bright patent. An extruded rubber/elastomeric covering material is taken to be the recited filler material, because as clearly illustrated in figure 6 of the

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Bright patent, the covering material fills voids in a preformed serpentine zig-zag configuration.

With respect to claim 10, see figure 2 of the Bright patent and column 1 lines 17-25 of the Matsumiya patent.

10. Claims 2 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered paragraph 7 or 9 as applied to claim 1 above, and further in view of Key (US 5,204,157).

Note: the recited filler material in claim 2 is taken to read on an extruded covering material. The rejection herein is alternative to the one set forth in numbered paragraph 7 or 9.

Matsumiya or King does not teach appear to teach providing a filler material to voids in a serpentine-configured wire strip. However, since Key discloses the use of a filler material to prevent "hungry horse" appearance (col. 1 line 52 to col. 2 line 7), it would have been obvious to one of ordinary skill in the art to use a filler in the strip of the primary reference in view of the teachings of Keys to provide a smooth outer surface to a resultant laminated strip. Note: the recited mask layer in claims 15-17 is taken to read on an extruded filler sheet (24) taught Key.

11. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered paragraph 7 or 9 as applied to claim 1 or 2 above, and further in view of either Burden et al (US 4,343,845) or FR 2,524,406.

In view that the limitations in claims 3 or 5 are conventional and well known in the art as exemplified in the teachings of either Burden (figures 1-2) or FR (figures 1-

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2), these claims would have been obvious in the art making a reinforced flexible laminate taught by King or Matsumiya.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference set forth in numbered 7 as applied to claim 1 above, and further in view of Schlegel (US 2,070,624) or GB 1,478,963.

In view that, Schlegel teaches the desirability of forming a reinforcing serpentine strand having a pair of legs which are formed of "*a V-shaped junction at the bend*" (figures 1 and 3-4), this claim would have been obvious in the art. GB '963 is further cited as a further evidence that it is known in the art to form a reinforcing serpentine strand having a pair of legs which are formed of "*a V-shaped junction at the bend*".

13. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered 7 or 9 as applied to claim 1 above, and further in view of Cook et al (US 5,072,567).

Matsumiya or King appears to be silent on forming various cross-sections of a continuous strand wire recited in these claims. However, it would have been obvious in the art to use the various cross-sections of a continuous strand wire recited in these claims, because it is old in the art to use a continuous strand having various cross-sectional configurations as exemplified in the teachings of Cook et al (col. 5 lines 36-43).

14. Claims 8 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered 7 or 9 as applied to claim 1 above.

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With respect to claim 8, since the recited materials for a carrier member is conventional in the art, this claim would have been obvious in the art.

With respect to claim 15-19, Matsumiya does not teach incorporating tape layer (25; taken to be a masking layer) illustrated in figure 3 with strand (9 and 13) layer illustrated in figures 1-3. However, it is now well settled "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose ... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069, CCPA 1980). Likewise, it would have been obvious to one having ordinary skill in the art to combine two known processes, each of which is taught by the prior art to be useful for the same purpose, to form a new process to be used for the same purpose. For this reason, it would have been obvious in the art to incorporate the embodiment illustrated in figure 3 to the embodiments illustrated figures 1-3.

Response to Arguments

15. Applicant's arguments filed 08-19-04 have been fully considered but they are not persuasive.

On page 8 last paragraph to page 9 line 2, Counsel argues that "*Matsumiya does not teach or suggest using its zig-zag strands on a pre-form length of continuous wire.*

Matsumiya only teaches the use of its strands on wire that has been knitted.". As best understood, Counsel appears to argue that, Matsumiya does not teach a) forming a pre-

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formed zig-zag wire and b) applying strands on the preformed zig-zag wire without knitting. Even for the sake of argument Counsel is correct, such would have been obvious in the art, because a) as noted earlier, Matsumiya is not restrictive to attaching axially oriented tapes or strands to a zig-zag serpentine configuration by stitching; and, b) it is old in the art to make a preformed zig-zag serpentine configuration and then to weld (i.e. without stitching) an axially oriented elongation reducing strands to the preformed a zig-zag serpentine configuration as exemplified in the teachings of King (col. 9 lines 25-32; figures 1-2). As for Counsel's argument on page 9 full paragraph 2, the same reason noted earlier, it would have been obvious in the art to manufacture a carrier taught by Matsumiya by making a preformed continuous zig-zag serpentine wire and then attaching axially oriented strands onto the serpentine configuration without stitching.

On pages 10-12, Counsel argues that, *"a uniform undulating wire pattern that results from knitted will result in a gaps in the wire support what will cause an uneven wire support. It is not possible to profile the loops, such as in Fig. 5 (and see attached) where loops on one side are different than on the other side (i.e. non-symmetrical)"*. It is respectfully submitted that, Counsel's argument is not commensurate with the scope of with at least independent claim 1. Nowhere in claim 1 remotely require forming *"loops on one side are different than on the other side."* Moreover, Matsumiya is not restrictive to forming a symmetrical serpentine wire illustrated in figures 1-4. See for example column 5 lines 11-17 of the Matsumiya patent. Moreover, a serpentine wire with a V-shaped clip is known in the art as exemplified in the teachings of Bright. As for the

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alleged benefits of making a preformed serpentine wire, such would necessarily flow from the method taught by Matsumiya where a serpentine wire is made before strands/tapes are attached to the wire with stitching.

As for Counsel's arguments on pages 12-13 regarding the Keys patent, it would appear that, Counsel is resorting to a classic piece meal analysis of references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). One in the art reading the collective teachings of Matsumiya and Keys would have been motivated to incorporate the teachings of Keys in a process taught by Matsumiya in order to eliminate a common practice of a formation of hungry horse effect during a bending operation. As for Counsel's assertion that, there is no suggestion why Matsumiya would have any desire to fill the voids in the wire with a filler of Keys. Examiner strongly disagrees. A "hungry horse effect" is a common problem in this art. One in the art wanting the practice the invention taught by Matsumiya reading the teachings of Keys would have been motivated to fill voids in a serpentine wire with a filler because Keys teaches performing such process step to "to eliminate a hungry horse effect on the outer surface of the cover layer 14 by the cover layers sinking into apertures 20,22 when the core member 23 is formed or bent" (col. 1 line 67 to col. 2 line 8; emphasis added). As for Counsel's argument regarding a carrier of Matsumiya being knitted, is Counsel suggesting that, a knitted carrier does not have a problem of a formation of

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hungry horse effect during a bending operation of a sealing strip? In any event, as noted earlier, it would have been obvious in the art to form a reinforcing carrier of Matsumiya, where a serpentine wire is preformed before axially oriented strands are attached to the serpentine wire without stitching. Counsel's argument that the process of Matsumiya (knitted) and Keys (non-knitted) is off-point.

As for Counsel's arguments on page 15 regarding Schlegel '624 or GB '963, Counsel basically repeated prior arguments that, a reinforcing carrier taught by Matsumiya is knitted. Even if true, it would have been obvious in the art, making a reinforcing carrier taught by Matsumiya, to pre-form a serpentine wire and then to attach axially oriented strands to the preformed serpentine wire without stitching for reasons set forth above.

As for Counsel's arguments on page 16 regarding claims 15-19, simply because Matsumiya does not expressly teach combining axially oriented strands and axially oriented tapes, it does not mean that, the teachings of Matsumiya as a whole would have suggested to one in the art to combine axially oriented strands and axially oriented tape. An obviousness question cannot be approached on the basis that an artisan having ordinary skill would have known only what they read in references, because such artisan must be presumed to know something about the art apart from what the references disclose. See *In re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA). As noted earlier, It is now well settled *"It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose ... [T]he idea of combining them flows logically from their having been individually taught in the prior art."* In re

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Kerkhoven, 626 F2d 846, 205 USPQ 1069, CCPA 1980). Likewise, it would have been obvious to one having ordinary skill in the art to combine two known processes, each of which is taught by the prior art to be useful for the same purpose, to form a new process to be used for the same purpose.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
09-30-04